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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,927	10/27/2003	Stephen C. Porter	03-264 (US01)	5083

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EXAMINER

WEBB, SARAH K

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,927

Applicant(s)

PORTER, STEPHEN C.

Examiner

Sarah K. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 2-5,8-11,13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-5,8-11,13, and 14 recite the limitation "agent carrier", which has no antecedent basis in claim 15. Claim 14 is indefinite because the claim requires the active element to absorb or adhere to a bioactive agent, but claim 15 from which it depends states that the active element can be made of the bioactive agent. The term "bioactive material" in line 2 of Claim 14 should be changed to "bioactive agent."

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 2-9,11-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,833,705 to Ken et al.

Ken discloses an occlusive coil with an agent carrier disposed within its lumen. The carrier (108,214) can be attached to the coil by adhesive at both ends or anywhere along the length of the coil (column 3, line 50 through column 4, line 11). Figure 1C shows that the carrier (214) can have a coil shape. The carrier can be made of various polymers, such as polyester, PGA, PLA, and silk (column 5, lines 25-40), which satisfy the requirements of claims 6-9. Ken states that the carrier (108,214) causes the occlusive member to resist stretching (column 3, lines 55-57), which is one way to retain the shape of the coil.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ken et al. in view of US Patent No. 6,953,465 to Dieck et al.

Ken fails to state that the material can be any of the substances listed in claim 10. Dieck discloses another vaso-occlusive device formed of vaso-occlusive polymeric materials. Dieck lists PGA as PLA as possible materials and teaches that poly(g-ethyl glutamate), poly(DTH-iminocarbonate), and poly(bisphenol A iminocarbonate) are suitable alternatives for forming a vaso-occlusive device (column 4, lines 33-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carrier of Ken from the alternate polymers taught by Dieck, as this is simply a substitution of functionally equivalent materials.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ken et al. in view of US Patent No. 5,658,308 to Snyder.

Ken fails to state that the carrier material absorbs or adheres the bioactive agent. Snyder discloses another occlusive coil (11) with a bioactive agent carrier (12) disposed within its lumen. The carrier (12) can be made of similar polymeric materials to Ken, such as PGA and PLA (column 2, lines 45-54). Snyder teaches that the carrier can be soaked in solution to absorb a bioactive agent (column 2, lines 33-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the carrier of Ken so that it absorbs a bioactive agent, as taught by Snyder, as this increases the versatility of the device and allows it to deliver a bioactive agent to the body.

Response to Arguments

5. Applicant's arguments, see page 5, filed 8/7/06, with respect to Snyder, have been fully considered and are persuasive. The 102 rejection under Snyder has been withdrawn.

6. Applicant's arguments filed 8/7/06 have been fully considered but they are not persuasive. Applicant argues that the stretch resistant member of Ken does not expand or contract to retain the shape of the occlusive member. Ken specifically states that the stretch resistant member is for the primary purpose of preventing stretching of the coil (abstract, line 9; column 1, lines 20-23), which is one way to "retain the shape" of the vaso-occlusive coil. The stretch resistant member inherently compresses and elongates with bending of the occlusive member as it is positioned in the body, but provides tension to the occlusive member to retain its shape. Further, the stretch resistant member is made of similar materials to applicant's invention, such as PGA, PLA, PTFE, and silk, so the stretch resistant member would exhibit similar mechanical properties to applicant's invention.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K. Webb whose telephone number is (571) 272-4706. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SKW
10/13/06

SKW
Julian W. Woo

JULIAN W. WOO
PRIMARY EXAMINER